

Application No.: 09/745,836
Amendment dated November 10, 2003
Reply to Office Action of September 16, 2003

REMARKS

In the Office Action, independent claims 34 and 40 were rejected pursuant to 35 U.S.C. § 102(b) as being anticipated by Snyder. Further, independent claim 28 was rejected pursuant to 35 U.S.C. § 103(a) as being obvious over Tasaki in view of Snyder. Claim 28 calls for a memory having stored therein a predetermined message for substitution in place of the respective caller ID value of a telephone at which the calling card is used. Claim 34 calls for a memory having stored therein a plurality of predetermined messages to replace the caller ID value for the telephone at which the calling card is used. Claim 40 calls for a memory having stored therein a plurality of predetermined messages, one or more of said plurality of messages to be received by a recipient communications device in place of the respective caller ID value of a telephone at which the calling card is used.

In the Reply to Paper No. 14 dated July 30, 2003, it was argued that Snyder does not anticipate claim 34 or 40 because Snyder supplements a caller ID value and does not replace the caller ID value. *See* Reply to Paper No. 14 at page 2. Further, it was argued that claim 28 is patentable over Tasaki in view of Snyder for essentially the same reasons. *Id.*, at page 3.

In Paper No. 16, a Final Office Action, it is stated "[t]he examiner see nowhere in the specification discloses the feature the stored messages are used for substitution in place of the respective caller ID value of a telephone at which the calling card is used." *See* Paper No. 16 at page 8. Further, it was stated, "the examiner does not agree that such stored messages are used for substitution in place of the respective caller ID value of telephone at which the calling card is used." *Id.* As a result, the Examiner "assumed and examined the limitations of claimed invention based on the disclosure of the specification, that is, 'supplementing a caller ID value'." *Id.*

The Examiner is kindly thanked for clarifying, via a telephone call on November 6, 2003, why he did not agree with arguments previously made. As such, an explanation in support of prior arguments is given. First and foremost, please refer to original claim 21. This claim calls

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for "a predetermined message for substitution in place of the respective caller ID value of a telephone at which the calling card is used", which is the exact limitation found in claim 28. Specification at page 12. *See also*, original claim 22. Further, in the abstract of the disclosure it is stated "a message card having a memory bearing a message for substitution in lieu of,...a caller ID value of a phone at which the message card is used." Specification at page 14. From this, it is clear that a telephone's caller ID value may be replaced and not supplemented by a message.

Additional support may be found in the Detailed Description section:

if (81) the user is calling from a phone with an unknown or indeterminate caller ID, or if (82) the user inputs a command to indicate that she wishes to override the default caller ID of that phone, the system prompts (85) the user for her personal identification number (PIN) or other suitable identification, which the user inputs (86) through the phone's input device (20). She may do this by... swiping her calling card through the phone's credit card slot or the like. Specification at p. 5, lines 14-16.

Thus, it is clearly stated in the specification that the default caller ID of a phone from which a call is being made may be override. An example of being overridden is given in the Detailed Description section:

Take the example where Alice is at Betty's house and wishes to phone Carla, but she knows that Carla will not answer the phone if her caller ID screen says the call is from Betty. This invention enables Alice to override this default condition, and cause the system to present Alice's custom ID information on Carla's phone. Alice may cause Carla's phone to present, for example: "Alice", or Alice's home phone number "(505) 555-1313", or "Alice coming to visit you", or whatever she wishes. Specification, page 6, lines 11-16. (Emphasis added).

Further, one result of using the message card 100 is a "call-less call" which transmits only the custom ID information. Specification at page 7, lines 24-25. These statements, taken together

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with original claims 21 and 22 make it exceedingly clear that the claims and prior arguments are supported by the specification.

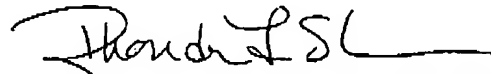
In the November 6, 2003, telephone conversation, the Examiner indicated that the exact words in the claim were not found in the specification. However, § 112 does not require that the exact same words in a claim appear in the specification. *See, Nelson v. Bower*, 1 U.S.P.Q. 2d 2076, 2078 (Bd. Pat. App. & Inter. 1986) (holding "it is not necessary that the claimed subject matter be described in *ipsis verbis* to satisfy the written description requirement of 35 U.S.C. § 112"). In this case, the exact words of claim 28 are found in original claim 21. Further, there is additional support in the specification for the claims as written, without importing limitations or other requirements, which would be improper. As such, the arguments asserted in the prior reply are reasserted herein. That is, Snyder supplements a caller ID value and does not replace it with a custom ID message. As such, it is respectfully submitted that claims 34 and 40 are not anticipated by Snyder as set forth in the prior reply, nor is claim 28 obvious over Tasaki in view of Snyder as previously explained.

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The application is believed to be in condition for allowance. Thus, claims 28 and 30-42 are believed to be allowable over the prior art. The Examiner's consideration of the remarks herein is respectfully requested.

Respectfully submitted,

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